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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JANANI JANAKIRAMAN and RABINDRANATH DUTTA

Appeal 2008-0413
Application 09/944,518
Technology Center 3600

Decided: July 11, 2008

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Janani Janakiraman and Rabindrana Dutta (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 22-39. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The invention is a method and system for extending battery life of a web browser-using mobile device, e.g., a cell phone, whereby a server transmits to the device only “non-essential” web objects.

Claim 22, reproduced below, is representative of the subject matter on appeal.

22. A method for preserving battery life for a portable networked client device, said method comprising the steps of:
 providing a web server with at least two sets of web objects for a web page, including at least one set of web objects previously designated as essential objects;
 receiving by said web server a battery condition from a networked client device;
 selecting only said essential web objects if said battery condition is low, otherwise selecting all said web objects; and
 transmitting said selected web objects from said web server to said networked client device so that remaining battery life is extended for said networked client device under conditions of low battery.

¹ Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Apr. 27, 2007), the Examiner’s Answer (“Answer,” mailed May 21, 2007), and the Reply Brief (“Reply Br.,” filed Jul. 23, 2007).

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

McLain	US 6,493,758 B1	Dec. 10, 2002
Agrawal	US 6,108,316	Aug. 22, 2000

The following rejections are before us for review:

1. Claims 22-39 are rejected under 35 U.S.C. § 103(a) as unpatentable over McLain and Agrawal.

ISSUES

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 22-34 as unpatentable over McLain and Agrawal. The issue turns on whether “Appellant’s claims are directed towards methods of restricting the information transmitted from a server to a mobile device based on battery level.” (App. Br. 6.)

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. Claim 22 refers to “web objects.” Web objects can be any typical object one would find on a web page, e.g., a photo, video file, etc.. Specification [0043].

2. The Specification ([0043]) talks of two sets of web objects – one being “normal [Wireless Markup Language] page content objects,” the other being “advertisement objects.” However, aside from the labels “normal” and “advertisement,” the Specification makes no distinction between the two sets of web objects. Accordingly, though claim 22 suggests two sets of web objects, they may be the same type of object one would find on a web page, e.g., a photo, video file, etc..
3. The Specification does not provide a definition for the term “essential” that would be different from its ordinary and customary meaning.

The scope and content of the prior art

4. Agrawal describes a server receiving a battery condition from a mobile device.
5. McLain describes a server sending web objects to a mobile device.

Any differences between the claimed subject matter and the prior art

6. The claimed invention combines steps separately disclosed in the prior art.

The level of skill in the art

7. Neither the Examiner nor Appellants have addressed the level of ordinary skill in the pertinent art preserving battery life for a portable networked client device. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level

and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Secondary considerations

8. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The Appellants argued claims 22-34 as a group (App. Br. 4-8). We select claim 22 (*see supra*) as the representative claim for this group and the remaining claims 23-34 stand or fall with claim 22. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

We have carefully reviewed the Appellant's arguments presented in the Briefs but find them unpersuasive as to error in the rejection because they are based on limitations that are not in the claim. "Many of appellant's arguments fail from the outset because, . . . they are not based on limitations appearing in the claims" *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

The Appellant's principal argument is that "Appellant's claims are directed towards methods of restricting the information transmitted from a server to a mobile device based on battery level." (App. Br. 6.) However, claim 22 covers the situation where there is no restriction on the transmission of information. To agree with the Appellant's construction of the claim would require us to read into the claim a step of determining a set of received web objects which, when transmitted, would extend the battery life of the mobile device.

Claim 22 is to be given the broadest reasonable construction consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). "The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.' *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir.

2004).” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005). “The problem is to interpret claims ‘in view of the specification’ without unnecessarily importing limitations from the specification into the claims.” *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003). When so construed, claim 22 encompasses transmitting web objects from the server to the mobile device without restriction.

The first step in the claim calls for providing the server with two sets of web objects, “at least one” designated as essential. This covers sending a web page with two photos, where both photos are “essential.” (See FF 1.) The second step calls for the server to receive a battery condition from the mobile device. The third step requires selecting only the essential web objects when the battery condition is low. However, there is nothing in the method to preclude the server from selecting, in the example above, both photos when the battery is low. The fourth step calls for transmitting the selected web objects. According to the example, this covers transmitting both photos. Accordingly, claim 22 is not limited, as the Appellant argues, to a method of restricting the information transmitted from a server to a mobile device based on battery level. There is no step in the claim for determining a set of received web objects which, when transmitted, would extend the battery life of the mobile device. Thus, there is no restriction that only some web objects are selected for transmission to the mobile device.

The Appellant’s argument that “[the cited references do not describe] using battery condition (or a variable condition) as a parameter to determine which essential or non-essential web page objects to transmit or not transmit from a server to a networked client in order to extend battery life” (App. Br.

7) is similarly not commensurate in scope with what is claimed. There is no step in claim 22 for determining which essential or non-essential web page objects to transmit or not to transmit from a server to a networked server client in order to extend the battery life of the mobile device. While this may be what the Appellant intended the claim subject matter to be drawn to, in its current form, the claimed method reads on sending web objects without restriction.

The Examiner found that McLain describes the claimed method except for the limitations involving battery life, for which the Examiner relied on Agrawal. The Examiner determined that

In view of Agrawal, it would be obvious to one of an ordinary skilled in the art, at the time of the applicant's invention, to have modified McLain to combine Agrawal's features of determining the condition of a battery in the mobile client device and transmitting said battery condition from said mobile client device to the web server because, as taught in Agrawal, it would enable the host computer in McLain to further improve its objective of downloading data in mobile client devices efficiently from web sources without wasting the memory's storage capacity of the mobile client device and instead increasing the expected life (see McLain col.2, lines 8-17) by prioritizing the transmission/downloading of essential data as per the users preference that is if the user has indicated preference for audio data then to transmit on priority the audio data excluding the text/graphical/video data in order to complete the downloading efficiently of the required data only before the battery becomes dead.

(Answer 6.)

We agree with the Examiner that claim 22, when given the broadest reasonable construction, reads on the combination of a server receiving a battery condition from a mobile device (Agrawal) and a server sending web objects to the mobile device (McLain). We are cognizant that claim 22 also includes the phrase “that remaining battery life is extended for said networked client device” in referring to the transmission of selected web objects. However, this does not exclude a method whereby web objects are transmitted without restriction.

The Appellants also argue that there is no teaching, suggestion, or motivation (App. Br. 7-8) to combine the references to reach the claimed invention. However, *KSR* clarified the standard for determining obviousness. As the Federal Circuit stated in *Leapfrog Ent., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007), “[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not.” (Citing *KSR*, 127 S.Ct. 1727, 1739 (2007)) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”)). Here, the claimed invention, when given the broadest reasonable construction, is simply the result of combining Agrawal’s step of the server receiving a battery condition from a mobile device and McLain’s step of the server sending web objects to the mobile device. In that regard, the Appellants have presented no evidence of unexpected results.

Accordingly, we sustain the rejection of claim 22.

CONCLUSIONS OF LAW

We conclude the Appellants have failed to show that the Examiner erred in rejecting claims 22-39 under 35 U.S.C. § 103(a) as unpatentable over McLain and Agrawal.

DECISION

The decision of the Examiner to reject claims 22-39 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

hh

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